

Remarks

As stated above, Applicants appreciate the Examiner's thorough examination of the subject application and request reexamination and reconsideration of the subject application in view of the preceding amendments and the following remarks.

As of the office action of February 9, 2009 (the "Office Action"), claims 1-31 were pending in the subject application. With this response, Applicants have amended claim 5 and withdrawn claims 3, 17, and 21.

A. Claim Objections

The Examiner objected to claim 5 because it contained a typographical error. *Office Action* at p. 3. In response, Applicants have amended claim 5 to correct the typographical error. Applicants respectfully request withdrawal of the objection to claim 5.

B. Rejections Under 35 U.S.C. § 102

The Examiner rejected claims 1-5, and 10-31 under 35 U.S.C. § 102(e) over U.S. Patent Application No. 2005/0022019 ("Medvinsky"). *Office Action* at p. 4. Applicants have withdrawn claims 3, 17, and 21. Applicants respectfully traverse the § 102 rejection and assert that claims 1-2, 4-5, 10-16, 18-20, and 22-31 are patentable under § 102 over *Medvinsky* because Applicants' invention pre-dates the *Medvinsky* reference. Please see the remarks regarding the Affidavits under 37 C.F.R. § 1.131 below. Accordingly, Applicants request withdrawal of the § 102 rejections of claims 1-2, 4-5, 10-16, 18-20, and 22-31.

In addition, Applicants request withdrawal of the § 102 rejections of claims 1-2, 4-5, 10-16, 18-20, and 22-31 because the *Medvinsky* reference does not appear to disclose or anticipate each and every element of the independent claims. For example, claim 1 recites:

1. (Original) In a client device, a method comprising:

receiving a request for playback of digital audio or video content stored on the device;

determining an allotted playback duration *for the device*;

determining an elapsed playback duration *for the device*, the elapsed playback duration representing an amount of time previously consumed by the device while rendering digital audio or video content;

determining whether a predetermined relationship between the elapsed playback duration and the allotted playback duration *for the device* is satisfied; and

regulating playback of at least the requested digital audio or video content if the predetermined relationship between the elapsed playback duration and the allotted playback duration *for the device* is determined to be satisfied. (Emphasis added).

As shown, the claims are directed toward allotted and elapsed playback durations associated with "the device." The subject application's specification describes the concept. For example:

[0020] In accordance with one aspect of the present invention, digital playback devices equipped with intrinsic digital content consumption rights are provisioned with rights monitoring logic to influence playback of digital content based upon a device usage model. In one embodiment, users may download content items to digital playback devices freely without concern as to the number of times the content has been previously downloaded or rendered by an authorized device, or the number of playback devices to which the content has been downloaded. In one embodiment, an elapsed playback time associated with a digital playback device is determined and compared to an allotted playback time for the device. In the event the elapsed and allotted playback times satisfy a predetermined relationship with respect to one another, further content playback on the device may be denied or otherwise regulated until content playback rights intrinsic to the device are renewed or "recharged". In a further aspect of the invention, a destructive rights transfer protocol is utilized to facilitate a non-aggregating user registration process for playback devices.

[0027] In one embodiment, playback rights associated with a playback device, such as playback devices 130, 135, 140 and 150 incorporated with teachings of the present invention, may be recharged so as to facilitate continued content playback by the device . . .

Subject Application at ¶¶ 20, 27 (emphasis added). Support for the concept may also be found throughout the remainder of the subject application's specification and drawings. As shown, allotted and elapsed playback times are playback times "for the device," as claimed.

However, *Medvinsky* appears to disclose playback times associated with specific piece(s) of media content.. For example, *Medvinsky* states:

[0014] The invention provides a system for restricting playback of an electronic presentation, such as a digital video presentation, song, etc. The system uses a playback time limit parameters that specifies a length, or duration, of allowable playback time. *The playback time limit is typically longer than the running time of the presentation so that a user is able to use standard transport controls such as pause, stop, rewind, fast forward, variable rate forward and reverse play, etc., that affect the overall playback time needed to view the presentation in its entirety. A preferred embodiment of the invention allows a user to view a presentation for 1.75 times the running time.*

[0053] In FIG. 4, flowchart 300 illustrates basic steps of a routine to restrict playback of a presentation according to a preferred embodiment of the present invention. Flowchart 300 is entered at step 302 when it is desired to monitor and restrict playback usage according to a playback time limit. At step 304 the current playback time limit is obtained. *As discussed, above, the "playback time limit" parameter can be obtained in a content license, such as in a data object, via a network at some time prior to playback of the associated content. The playback time limit can also be obtained by other means such as embedded with the presentation, or content, received from a source other than the network, etc.*

Medvinsky at ¶¶ 14, 53 (emphasis added). *Medvinsky* appears to disclose playback times that are associated with media content. For example, *Medvinsky* states that "the invention allows a user to view a presentation for 1.75 times the running time [of the presentation]." *Medvinsky* also states that the playback time limit can be "obtained in a *content* license." These passages indicate that *Medvinsky's* time limits are based on and associated with media content. Therefore, *Medvinsky's* time limits are not analogous to the elapsed and allotted playback durations claimed in the subject application and described in the specification because *Medvinsky's* time limits appear to be dependent upon and based upon particular media content. In contrast, the playback durations of the claims are "for the device" and are independent of any particular media content. *See e.g. Subject Application* at ¶¶ 20, 27.

Applicants contend that *Medvinsky* does not disclose each and every element of the claims because *Medvinsky's* time limits do not appear to be analogous to the playback durations in the claims. Accordingly, Applicants request withdrawal of the § 102 rejection of claims 1-2, 4-5, 10-16, 18-20, and 22-31.

C. Rejections Under 35 U.S.C. § 103

The Examiner rejected claims 6-8 under 35 U.S.C. § 103/102(a) over *Medvinsky* and U.S. Patent No. 5,586,264 ("Belknap"). *Office Action* at p. 15. As noted, Applicants assert that claim 1 is patentable under § 102 over *Medvinsky*. Therefore, Applicants respectfully traverse the § 103 rejection because claims 6-8 are ultimately dependent upon claim 1 and include all its limitations. Accordingly, Applicants respectfully request withdrawal of the § 103 rejection of claims 6-8.

D. Affidavit under 37 C.F.R. 1.131

Applicants have included two affidavits under 37 C.F.R. § 1.131 (the "131 affidavits") with this response. Applicants contend that the affidavits evidence the fact that Applicants invented the claimed subject matter prior to the date of the *Medvinsky* reference. The 131 affidavits show conception of the claimed subject matter prior to the *Medvinsky* reference, and also show that Applicants' diligent pursuit of reduction to practice of the claimed subject began before the *Medvinsky* reference was filed and continued at least until the subject application was filed.

If an applicant's invention pre-dates a reference, the reference is not prior art under § 102. 35 U.S.C. § 102. An applicant can show that their invention pre-dates a reference by showing that the applicant conceived of the invention before the filing date of the reference and that the applicant diligently pursued reduction to practice until the invention was realized, or until the

invention was constructively reduced to practice (i.e. the patent application was filed). *See* M.P.E.P. § 715.07(III).

The 131 affidavits included with this response show that Applicants conceived of the claimed invention prior to the effective date of the *Medvinsky* reference, and that Applicants diligently pursued reduction to practice at least until the subject application was filed.

The *Medvinsky* reference has an effective date of July 5, 2003. The 131 affidavits show that Applicants conceived of their invention prior to July 5, 2003. For example, the 131 affidavits state:

Prior to July 5, 2003, the invention claimed in the subject application was disclosed in an Invention Disclosure Form. A true and accurate copy of the Invention Disclosure Form is attached as Exhibit A, except that the copy has been redacted to remove all references to dates. The Invention Disclosure Form (i.e., Exhibit A) evidences the conception of the invention claimed in the subject application, which occurred prior to July 5, 2003.

131 affidavits at ¶ 8 (emphasis added). Paragraphs 6-36 of the 131 affidavits map each element of the claims to the text of the Invention Disclosure Form. Since the Invention Disclosure Form was created prior to July 5, 2003, the mapping shows that each element of the claims was conceived prior to the effective date of the *Medvinsky* reference.

The 131 affidavits also show that the Applicants (and RealNetworks, Inc., the assignee and employer of the Applicants) diligently pursued reduction to practice, and that the pursuit began prior to *Medvinsky's* effective date and continued, without lapse, through the date the subject application was filed. Paragraphs 37-50 of the 131 affidavits point out and describe emails and documents created by RealNetworks, Inc. ("RealNetworks") employees relating to the design and development of the claimed subject matter. The emails and documents refer to the "Orange" protocol. "Orange" is a code-word used by RealNetworks employees to refer to a licensing protocol project. The "Orange" protocol includes the claimed subject matter, and other

licensing features required for the claimed subject matter. *See* 131 Affidavits at ¶¶ 39-42. For example, the 131 affidavit states:

40. Exhibits B through I reference the Orange Protocol. "Orange" is a code name that was used by employees of RealNetworks to refer to the portions of the Helix Device DRM project which included work on necessary prerequisites for the invention claimed in the subject application. Other portions of the Helix Device DRM project implemented the invention claimed in the subject application after the necessary prerequisites had been implemented..

41. The Orange Protocol is a licensing protocol based on user subscriptions and allotted playback-time based on user subscriptions, as opposed to traditional content licensing models where licensing is based on media content or media files. The base components of the Orange Protocol are components that send an authenticated subscription or playback-time license to a device in a flexible and secure manner.

42. In order to implement the claimed invention, it was necessary to first implement the base components of the Orange Protocol because a) the base components facilitate secure, authenticated transmission of messages to the device, a necessary prerequisite for services that interact with devices in the embodiment of the claimed invention we were reducing to practice, and b) the base components provide the basic building blocks of a subscription or user-account subscription license, which is a necessary prerequisite to tracking allocation of elapsed playback time by the user-account in the embodiment of the claimed invention we were reducing to practice.

See e.g. 131 affidavit at ¶¶ 40-42. These facts in the 131 affidavits show that RealNetworks employees were working diligently on the Orange protocol and implementation of the claimed invention.

The 131 affidavits show that RealNetworks and its employees diligently continued to work on the Orange protocol and the claimed invention because the emails show continued revisions of and communications regarding the licensing protocol. *See* 131 Affidavits at ¶¶ 38-53. The emails and documents described in the 131 affidavits (and included as exhibits to the 131 affidavits) show that RealNetworks employees were pursuing reduction to practice of the invention, through development and implementation of the Orange protocol, beginning prior to

the *Medvinsky* filing date and continuing through the filing date of the subject application. *Id.*

The affidavits and their exhibits show that RealNetworks employees were communicating about the Orange protocol and updating documentation relating to the Orange protocol from prior to July 5, 2003 (the *Medvinsky* reference) through November 21, 2003 (the subject application's filing date). The 131 affidavits also shows that development of certain base features of the Orange protocol was necessary in order to develop and implement the claimed invention. 131 Affidavit at ¶¶ 38-42.

As stated in the 131 affidavit, constructive reduction to practice occurred on Nov. 21, 2003, the filing date of the subject application. 131 Affidavits at ¶ 52.

The 131 affidavits show that a) conception of the claimed invention occurred before *Medvinsky's* filing date, b) diligent reduction to practice began prior to *Medvinsky's* filing date and continued, without lapse, through the filing date of the subject application, and c) the invention was constructively reduced to practice on Nov. 21, 2003 when the subject application was filed. Based on this evidence, Applicants respectfully contend that the *Medvinsky* reference is not prior art under 35 U.S.C. § 102, and request withdrawal of the § 102 rejections of claims 1-2, 4-5, 10-16, 18-20, and 22-31.

E. Definitions

The Examiner adopted definitions for various terms in the subject application's specification and claims. *Office Action* at pp. 17-18. The Applicants respectfully object to and disagree with some or all of the Examiner's adopted definitions and reserve the right to suggest, argue, and/or adopt alternate definitions of the terms defined by the Examiner.

The Examiner adopts these definitions in reliance on *In re Morris* and the broadest reasonable interpretation standard. *Id.* Applicants acknowledge that the Examiner may use the

broadest reasonable interpretation standard to define terms for the purpose of examination. *In re Morris*, 127 F.3d 1048 (Fe. Cir. 1997). However, the broadest reasonable interpretation standard is not the same standard used by courts to interpret and construe issued claims. *Id.* Therefore, the Applicants do not believe the Examiner's definitions create binding prosecution history estoppel, and Applicants reserve the right to suggest, argue, or adopt alternate definitions for those terms defined by the Examiner, should the need arise.

F. Conclusion

In consideration of the amendments and foregoing discussion, the application is now believed to be in condition for allowance. Early allowance of the subject application is respectfully solicited.

This response is not believed to necessitate any additional fees. However, in the event that additional fees are due, please charge or credit any refund to our Deposit Account No. 50-2324.

Respectfully Submitted,

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